

### **Remarks**

Applicant appreciates the careful examination given to the Application as reflected in the Office Action mailed June 9, 2008. Reconsideration and favorable action in the Application is respectfully requested.

Claims 1-51 are pending in the Application.

Claims 1-51 stand rejected.

Claims 1, 2, 8-10, 12, 15, 17-18, 20-23, 28, 29, 32, 34, 36, 40, 46, 48-50 have been amended.

Claims 3, 5-7, 11, 13, 14, 16, 19, 24-27, 30-31, 33, 35, 37-39, 41-45, 47 and 51 have been cancelled.

### **§101 Rejection of Claims**

**The Office Action rejected claims 1-31 and 48-51 under 35 U.S.C. §101 for being a nominal use of technology wherein no information is being processed and therefore being directed to non-statutory subject matter.**

The Federal Circuit in *In re Bilski* set guidelines for patentable subject matter under 35 U.S.C. §101. *In re Bilski*, 264 Fed. Appx. 896 (Fed. Cir., 2008). The Federal Circuit adopted the “machine or transformation” test. The “machine or transformation test” states that a claimed process is patent-eligible under §101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. The machine test is not one of physicality. Therefore, physical steps are not required of a claim. However, all of the required steps of a claimed process cannot be performed entirely in the human mind.

The transformation test requires two separate conditions: (1) that the transformation is central to the purpose of the claimed process and (2) that the transformation relate to a physical

object or substance. Transformation of data is patent-eligible subject matter if it “represents the physical and tangible objects.” *In re Bilski*, 264 Fed. Appx. 896 (Fed. Cir., 2008).

Claim 1 has been amended. Claim 1 is now directed to a method where a software program is used to generate a numerical total of a set of status indicators, among other things. Generating a numerical total is a transformation of information by a computer (changing a discrete number of status indicators into a total) greater than a nominal use of technology. Further, the information is related directly to a geotechnical construction project which is a physical thing. Under *In re Bilski* Applicant submits that claim 1 now recites patentable subject matter.

Support for the amendments to claim 1 can be found in the specification as follows: Support for the system comprising a software program operating on a computer can be found at paragraphs 0047 and 0051 of the specification. Support for a geotechnical construction site is found at paragraphs 0069 and 0097. Support for the codes that relate to the set of questions is found at paragraphs 0122-0127 and tables 1 and 2. Support for the interrelationship of the question, risk and contacts databases can be found at paragraphs 0056-0059. Support for a program that associates the question and an answer is found at paragraphs 0050-0053 and 0084-0085. Support for graphical display of the indicators and generating a total can be found at paragraphs 0118-0120 and 0173.

Claims 2, 4, 8-10, 12, 15, 18 and 19 depend from claim 1. Since claim 1 now recites statutory subject matter, claims 2, 4, 8-10, 12, 15, 18 and 19 recite statutory subject matter as well. Applicant respectfully requests that these rejections be withdrawn.

Claims 3, 5-7, 11, 13, 14 and 16 have been cancelled. The rejection of these claims is now moot.

Claim 20 has been amended to claim statutory subject matter. Claim 20 as amended is directed to a software system, residing on a computer network including a database association program that is programmed to associate answers with questions and correlate questions with risks, among other things. The data is all associated with a geotechnical construction site so it refers to physical parameters (like soil stability). It is submitted that the claim passes muster under *In re Bilski* and so is patent-eligible.

Support for the amendments to claim 20 to include a software program is found in paragraphs 0047 and 0051. Support for a geotechnical construction site is found at paragraphs 0069 and 0097. Support for the interrelationship of the question, risk and contacts databases can be found at paragraphs 0056-0059. Support for a first and second data entry form is found at paragraphs 0097-0098. Support for a database association program is found at paragraphs 0050-0053 and 0084-0085.

Claims 21, 24-27, 30 and 31 depend from claim 20 and therefore the rejection of these claims should be remedied by the amendment to claim 20.

Claims 22, 23, 28 and 29 have been cancelled; therefore, the rejection of these claims is moot.

Claim 48 has been amended to claim statutory subject matter. Claim 48 as amended is directed to a method of providing a software program that correlates discipline codes with a set of disciplines and numerically sorting and tallying risks. "Correlation", "sorting" and "tallying" are computational tasks that transform data related to a building project which provides patent-eligible subject matter.

Support for the amendment related to a building project is found at paragraphs 0123-0127. Support for the system comprising a software program operating on a computer can be

found at paragraphs 0047 and 0051 of the specification. Support for the interrelationship of the question, risk and contacts databases can be found at paragraphs 0056-0059. Support for receiving an answer to a question, correlating, sorting and tallying can be found at paragraphs 0058, 0129-0131 and Tables 1-2.

Claims 49 and 50 depend from claim 48 and therefore the rejection of these claims should be remedied by the amendment to claim 48.

Claim 51 has been cancelled.

### **§112 Rejection of Claims**

**The Office Action rejected claim 50 as indefinite under 35 U.S.C. §112 (1).**

Claim 50 has been amended. Claim 50 as amended replaces the term “statistical mapping” with language to accurately defines the invention and now passes muster under § 112(1). Applicant requests that the rejection be withdrawn.

**The Office Action rejected claims 20-39, and 50 as indefinite under 35 U.S.C. §112 (2).**

Claim 20 has been amended to replace “dialog mechanism” with “data entry form.” The specification supports this definition. Dropdown menus are disclosed to select the project at paragraph 0097. Forms for entry of various data are included at paragraph 0105. Check boxes are disclosed in paragraphs 0089 and 0119.

The “term association engine” has been replaced with “database association program”. Support can be found at paragraph 0084 which shows a “standard query and report engine” that has access to all databases via the database manager. Paragraph 0053 states that the various databases are relational.

Claims 21-30 depend from claim 20 and therefore the rejection of these claims should be remedied by the amendment to claim 20.

Claim 31 has been cancelled, so the rejection of this claim is moot.

In claim 32, the term “dialog box” required clarification. The use of the term is supported by the specification but the claim has been amended to set out a “data entry form” well understood in the art. Dropdown menus are disclosed to select the project at paragraph 0097. Boxes for entry of various data are included at 0105. Check boxes are disclosed in paragraphs 0089 and 0119. Applicant respectfully requests that this rejection be withdrawn.

Claims 33-39 were rejected based on their dependence on claim 32. Therefore, Applicant also respectfully requests that these rejections be withdrawn.

Claim 35 has been cancelled.

Claim 50 has been amended to eliminate the limitation “statistical mapping” and further define the claimed invention. The terms now used in the claim are now clearly supported by the specification. Support can be found at paragraphs 0011, 0098, 0119, 0132, 135 and 0172-173.

### **§103(a) Rejection of Claims**

**The Office Action rejects claims 1-6, 9, 12, 15 and 19 as being unpatentable over of *Phelps et. al.* (U.S. Patent App. 2003/0088446) in view of *Bowman-Amuah* (U.S. Patent App. 2001/0052108).**

The Supreme Court in *KSR Int’l V. Teleflex, Inc.*, 127 S.Ct. 1727, 82 U.S.P.Q. 2d 1385 (2007) stated that in order to adequately support a rejection under 35 U.S.C. §103 a clear articulation of the reason(s) why the claimed invention would have been obvious is required. Further, the analysis supporting such a rejection under 35 U.S.C §103 must be made explicit.

The Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusionary statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F3rd 977, 78 U.S.P.Q. 1329 (Fed. Cir. 2006).

The Supreme Court in *KSR* identified a number of rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as laid down in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). These rationales include:

- A. Combining prior art elements according to known methods to yield predictable results;
- B. Simple substitution of one known element for another to obtain predictable results;
- C. Use of known technique to improve similar devices (methods, or products) in the same way;
- D. Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- E. “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- F. Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art; and,
- G. Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

In combining the cited references, the Office Action appears to adopt the “G” rationale by arguing that some teaching, suggestion or motivation in the prior art would have led one of

ordinary skill to modify some combination of the prior art references or combine them to arrive at the claimed invention.

Under the teaching, suggestion, motivation rationale, it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification. *In re Lalau*, 747 F.2d 703, 223 U.S.P.Q. 1257, 1258 (Fed. Cir. 1984).

Furthermore, it is not enough for the Office Action to present references that contain the assorted features of the invention. The Office Action must also state explicitly why it would appear that the references would have been combined. *See, In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992) (The examiner can satisfy this burden only by showing some objective teaching in the prior art or that some knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references).

A further indication of a potentially defective obviousness rejection is the inclusion of separate references to represent each of the different features that are described in the claims of the application. In this situation, many times the claimed invention has been used as an “instruction manual” to piece together prior art that might render the claims obvious. In this process the Office may have lost sight of the real issue, that is, whether it would have been obvious to combine the references without having access to the application that is under examination to arrive at the claimed invention. *See, e.g., Ex Parte Crawford, et al.*, Appeal No. 20062 429, decided May 30, 2007; *See, also, Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 221 U.S.P.Q. 1025, 1033 (5th Cir. 1984). It is impermissible for the Office Action to use the

application itself as the basis or reason for formulating the obviousness rejection. As worded by the Federal Circuit:

It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This Court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2D 1780, 1784 (Fed. Cir. 1992).

The Federal Circuit has stated:

Most if not all inventions arise from a combination of old elements. Thus every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the Applicant. *In re Kotzab*, 217 F.3d 1365, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000).

Finally, the Supreme Court has indicated that "common sense" should be observed in the determination of obviousness. *KSR* 127 S. Ct. at 1727, 82 U.S.P.Q. 2s at 1397. The BPAI has further instructed that obviousness must be judged from the perspective of an artisan exercising common sense to combine the teachings of numerous references. *See, Ex Parte Green*, Appeal 2007 1271, decided June 12, 2007; also *See, Ex Parte Rinkevich, et al.*, Appeal 2007 1317, decided May 29, 2007.

It is respectfully submitted that the Office Action does not make out a prima facie case of obviousness because it has not presented sufficient reasoning as to why the invention would have been obvious to one of ordinary skill in the art of risk assessment systems in view of the references cited. It is further submitted that the references cited, either alone or in combination, do not disclose all the elements of the claims (as amended) nor would it have been obvious to of



ordinary skill in the art how to achieve the structure and advantages of the claimed invention. Still further, Applicant asserts that there is insufficient suggestion or motivation to combine the references and that the references teach away from the combination.

Applicant asserts that it is improper to combine the *Bowman-Amuah* reference with the *Phelps* reference. *Phelps* relates to a system for assessing risks in construction projects. The *Bowman-Amuah* reference relates to a method of managing and developing software, rather than the field of risk assessment. See, abstract, paragraph 0002, 0008, 0083, 0496, 0538. *Bowman-Amuah* discloses software to divide software modules into discrete components and manage delivery of those modules to ensure a timely completion of the software. See, abstract, paragraphs 0002, 0008, 0083. The *Bowman-Amuah* reference does not disclose a method of analyzing “risks” as they relate to a physical construction project.

One of reasonable skill in the art exercising common sense would not combine references that deal with such different subject matter even if both references deal with software. Therefore, one having skill in the art of risk assessment systems would not look to the *Bowman-Amuah* reference for a solution to a shortcoming in *Phelps*. Applicant respectfully submits that combining *Bowman-Amuah* with *Phelps* is an assembly of non-analogous prior art using Applicant’s disclosure as a template. Such is not appropriate. See, *In re Fritch*, 972 F.2d 1260.

With respect to claim 1, the Office Action asserts that Figure 2 of *Phelps* discloses the step of “selecting a risk from the risk database related to the answer and viewing the risk as required by Applicants invention.” The Office Action asserts that a user selecting a type of risk review, where the subsequent questions asked and answered are related to the type of risk and risk review, is the same as “selecting a risk from the risk database related to the answer and viewing the risk.”

The two are not the same. On the one hand, Figure 2 of *Phelps* discloses a display page where a user to selects a “review type” from a selection of “review type fields.” A “review type” is a category of fields that allow a user to specify the type of review that the construction project may require. Examples of “review types” include: “if a contract has been approved”, “if a contract is fully negotiated”, or “if there has been an engineering or manufacturing release”. When a review type is selected, a series of questions is generated specific to that review type. Paragraphs 0023 and Fig. 2. A “review type” of *Phelps* is not a specific answer to a discrete question; rather it determines the nature of the questions that are asked in the review. *See*, Figure 2 and paragraph 0023. *Phelps* uses “risk type” to mean a single discrete risk, such as “noise level”, “schedule/delay” or “finance”. Paragraphs 0023 and 0029. A “risk type” is not related to the questions asked.

On the other hand, a “risk” as the term is used by Applicant is a *set of statements* describing actions that need to be taken in response to a users answer. The “answer” is related to a *single question*. *See*, paragraph 0057. The answer can only be “yes”, “no” or “don’t know”. Additionally, the “risk” of Applicant is associated with a discipline. This association is not found in *Phelps*. *See*, paragraph 0057.

In short, *Phelps* generates questions in response to a category of review. Applicant generates categories of actions in response to answers to questions. Thus, a user selecting a type of risk review, where the subsequent questions asked and answered are related to the type of risk and risk review, is not the same nor does it make obvious “selecting a risk from the risk database related to the answer and viewing the risk,” as disclosed and claimed by Applicant.

The Office Action correctly admits that *Phelps* fails to disclose “a question database having a question relating to the project.” However, the Office Action incorrectly assumes that it

would be obvious for one of ordinary skill in the art to modify *Phelps* to include a questions database containing different questions which are *associated* with the risk data.

The questions of the Applicant's invention are associated with the risk data and also include fields ("codes") that associate them with a specific discipline. Furthermore, claim 1 as amended now requires the specific discipline related codes. It would not be obvious to one having ordinary skill in the art to modify the *Phelps* to include such codes or to create a question database containing the specific question sets as claim 1 now requires because *Phelps*.

With respect to the Office's assertion that *Bowman-Amuah* discloses a "contact" and "contact database" as the terms are used by Applicant, Applicant respectfully disagrees. The contacts of the *Bowman-Amuah* reference are merely external vendors and their contact information. Applicant has amended the claim to further distinguish over the prior art by requiring that the contacts have a contact code associated with a specific discipline and a specific risk, so that a person of correct discipline may be contacted with regard to a specific risk. Para. 0115. Neither *Bowman-Amuah* nor *Phelps* disclose or suggest this limitation.

Claim 2 as amended now requires a set of users associated with the set of contacts and the set of contacts has a contact code. The prior art does not suggest or disclose a user associated with a set of contacts or a set of contact codes related to disciplines as claimed by Applicant. Support for the "set of contacts" related to a user can be found at paragraphs 0087-0088.

Claim 3 has been canceled.

Claim 4 depends from claim 1 and so should be patentable in view of the amendments to Claim 1.

Claims 5 and 6 have been canceled.

Claim 9 has been amended. As currently amended claim 9 requires providing a set of information and a set of information at the information addresses related to the set of questions. Such a limitation is not disclosed or suggested by the prior art. Support is found at paragraphs 0056 and 0164.

With respect to claim 12, the Office Action argues that *Phelps* discloses “modifying the risk.” *Phelps* discloses modifying the risk data that has been input, thus altering the type of risk message that is displayed. *See*, paragraphs 0038-39. But “modifying the risk”, as the term is used by Applicant, includes marking the risk as addressed or completed. “Marking” the risk as completed reduces the overall risk to the project that is displayed. “Marking” does not alter the type of risk message that is displayed. Thus, the term “modifying the risk” as used by Applicant is not the same as the use of the term in *Phelps*. Hence, *Phelps* does not disclose or suggest the limitations of Claim 12. Applicant submits that Claim 12 sets out patentable subject matter.

With regard to claim 15, the Office Action admits that the combination of prior art does not disclose “modifying the contact.” The contacts that *Bowman-Amuah* discloses are merely external vendors and their contact information. Claim 15 (as amended) requires matching a contact code with a group of questions. “Modifying the contact” is clearly not the same as “matching a contact code”. Support for the amendment can be found at 0059 and 0115.

Claim 19 has been canceled.

**Claims 7, 8, 10, 11, 13 and 14 were rejected under §103(a) based on a combination of *Phelps* in view of *Bowman-Amuah* and further in view of *Tschiegg '05*.**

Applicant here reasserts its arguments as to the combination of *Phelps* and *Bowman-Amuah* as set out above.

Claim 7 has been cancelled.

Claim 8 has been amended to require the step of providing a set of information addresses correlated to the set of questions. The prior art does not disclose or suggest this feature of Applicants invention as claimed. Therefore, Claim 8 is submitted to be patentable. Support may be found at paragraph 0056.

Claim 10 has been amended to require providing a set of information addresses correlated to the set of risks and providing a set of information at each information address where the information is related to a risk from a set of risks. The prior art does not disclose or suggest this feature of Applicants invention as claimed. Therefore; claim 10 is submitted to be patentable.

Claims 11, 13, 14 have been cancelled.

**Claim 16 was rejected under §103(a) based on a combination of *Phelps* in view of *Bowman-Amuah* and further in view of *Barber*.**

Applicant incorporates here its arguments as to the combination of *Phelps* and *Bowman-Amuah* as set out above.

Claim 16 has been cancelled.

**Claim 18 was rejected under §103(a) based on a combination of *Phelps* in view of *Bowman-Amuah* and further in view of *Chung*.**

Applicant here incorporates its arguments as to the incorrectness of the combination of *Phelps* and *Bowman-Amuah* as set out above.

*Chung* relates to the art of determining contract compliance rather than the art of risk assessment. See, abstract paragraphs 0006, 0012, 0032. A person having ordinary skill in the art would not be motivated to combine *Chung* with *Phelps*, as *Chung* does not relate to the art of risk assessment. It is respectfully submitted that combining the *Chung* reference with *Phelps* and

*Bowman-Amuah* is an assembly of non-related prior art using Applicant's invention as a template. *See, In re Fritch*, 972 F.2d 1260.

Further, the "event database" in *Chung* is not the same as the "event database" in Applicant's invention. An "event" in *Chung* includes timing and measurement of occurrences on a system. An "event" in Applicant's disclosure includes system events and a record of the IP address, web address, and computer ID where the event originated. *See*, paragraphs 0063-65. "Event database" as the term is used by Applicant includes storage of information related to the identity of a user, such as the users IP address, web address, and computer ID. Thus, the "event database" of *Chung* is not an "event database" as the term is used by Applicant.

Further, Claim 18 has been amended to require a set of events which identifies a user's computer. The prior art does not disclose or suggest recording events (as that term is used by Applicant). Therefore Applicant submits that claim 18 is patentable. Support is found in paragraphs 0063-0065.

**The Office Action rejects claims 20, 31 and 48 under 35 U.S.C. § 102(e) as being anticipated by *Phelps*.**

Anticipation under §102 (e) requires that a single piece of prior art disclose each and every element of the claimed invention as arranged in the claim. *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1983); *See, In re Paulson*, 30 F.3d 1475, 31 U.S.P.Q.2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 U.S.P.Q.2d 1655 (Fed. Cir. 1990). For anticipation, there must be *no difference* between the claimed invention and the referenced disclosure. *Scripps Clinic and Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 U.S.P.Q.2d 1001 (Fed. Cir. 1991). The absence from the reference of any claimed element negates anticipation. *Closter Speedsteel AB v. Crucible, Inc.*, 793 F.2d

1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986). If a *prima facie* case of anticipation is not established, then without more, Applicant is entitled to a patent. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992).

As to Claims 20 and 48, the Office Action admits that *Phelps* does not disclose “a question”, “a question database”, “a risk ID”, a “question ID” and “storing the question ID and the risk ID in the project database”. Instead, the Office Action asserts, without support, that it would be obvious to modify the disclosure of *Phelps* to include these elements. If the Office Action has taken official notice that these features are well known, Applicant respectfully requests supporting evidence. *See*, MPEP§2144.03(A); *Also See*, *In re Ahlert*, 424 F.2d 1088, 165 U.S.P.Q. 418 (C.C.P.A. 1970). It is respectfully asserted to merely state the advantage of these elements as recognized by Applicant, as done by the Office Action, is insufficient under §102 to support a case of anticipation. Furthermore, even under §103 such reasoning is insufficient to support a case under *KSR Teleflex*. Put simply, the reference does not anticipate the invention nor is there sufficient reason to conclude that all these elements are obvious.

Still further, Claim 20 has been amended to include a “question code” and a “risk code” and the software program carrying out the steps of correlating the question with the risk by associating the codes. *Phelps* does not disclose or suggest the limitations of amended Claim 20.

Claim 48 has also been amended to include the limitation of “discipline group codes” in association with the questions and the risk. Support can be found in paragraphs 0056-0058. The prior art does not disclose or suggest a question or a risk associated with a discipline group code as claimed by Applicant. Therefore, neither *Phelps* nor the prior art of record discloses or suggests of the limitations of claim 48.

Because *Phelps* does not disclose or suggest all the elements of claims 20 and 48, a case of anticipation has not been made out and the rejections should be withdrawn.

Claim 31 has been cancelled.

**Claims 21-27 and 29-31 were rejected under § 103(a) based on a combination of *Phelps* in view of *Tschiegg* '03.**

Claim 21 has been amended to further define and distinguish the invention from the prior art. Claim 21 now requires the database association program to assign a numerical value to the risks, calculate a total and display it to aid in risk evaluation. The prior art does not disclose or suggest such a feature. Support for the amendment is found in paragraphs 0118-0120.

Claim 22 has been amended to further distinguish the invention. Claim 22 now requires first and second sets of distributed information sources related to the questions and risks, respectively. Claim 22 also requires the database association program associates the first set of distributed information sources with the questions through a set of uniform resource locators and associates the second set of information sources with the risks through a second set of the informant resource locators. The prior art does not disclose or suggest such a feature. Support for the amendment is found at 0056-0057 and 0164-0172.

Claim 23 has been amended to further distinguish the invention. Claim 23 requires that a changeable graphical icon be displayed of a completed risk. The prior art does not disclose or suggest such a feature in combination with the other features of claim 11 from which claim 23 depends. Support for the amendment can be found at paragraphs 0119-0120.

Claim 24 has been amended to further distinguish the invention. Claim 24 requires that a changeable graphical icon of an incomplete risk be displayed. The prior art does not disclose or



suggest such a feature in combination with the other features of claim 11 from which claim 24 depends. Support for the amendment can be found at paragraphs 0119-0120.

Claims 25-28 have been cancelled.

In claim 29 the Office Action correctly admits that *Phelps* does not disclose a URL associated with the question and linked to information related to the question. However, the Office incorrectly asserts the *Tschiegg '03* discloses such a URL. *Tshciegg '03* discloses an email notification system. Users signed up for the notification receive a URL that links to the location of status updates. *See*, paragraphs 0011-12, and 0087. The URL of *Tschiegg '03* merely points to a web location where project update status data resides. Conversely, the URL of Applicant points to an information set that supplies additional (supplemental) information about the question or risk to explain the question or risk as opposed to merely updating status. *See*, paragraph 0056. Thus, *Tschiegg '03* does not disclose “URL associated with the question and linked to information related to the question” as disclosed and claimed by Applicant.

Claim 29 has also been amended to further distinguish the invention. The features now claimed clearly distinguish over the prior art. Support for the amendment can be found at paragraphs 0118-0120.

Claim 30 has been cancelled.

Claim 31 has been cancelled.

**Claim 28 was rejected under § 103(a) based on a combination of *Phelps* in view of *Tschiegg '03* and further in view of *Tschiegg '05*.**

Claim 28 has been amended to more clearly define the invention. Claim 28 now requires the database association program to display a first and second icon for a complete risk set and an incomplete risk set, respectively, and also grouped according to “risk code” The specification

supports this amendment as paragraphs 0011, 0118-119. *Teschiegg '03* discloses only text to indicate “active” or “complete”. *See*, paragraph 0087. *Teschiegg '03* does not include a non-textual graphical presentation that indicates a risk’s current state or grouped according to risk code. Further, the icons of *Teschiegg '05* represent subdivisions of risk information available through a drill down menu. *See*, paragraphs 0055, 0178-180. Based on the icon selected by the user, a different level of risk report is viewed. However, the icons of *Teschiegg '05* do not reflect the *current state of that risk*. The icons of *Teschiegg '05* do not provide a method of evaluating risks as required by the “graphical presentation” limitation of Applicant. *See*, paragraphs 011, 0118-119 thus, the combination of *Phelps* and the text display of *Teschiegg '03* does not disclose or suggest the invention of Applicant as claimed.

**Claim 32 was rejected under § 103(a) over *Phelps* in view of *Bowman-Amuah* and further in view of *Leblanc*.**

Applicant reasserts its arguments as to the combination of *Phelps* and *Bowman-Amuah* here as if fully repeated.

Claim 32 has been amended to include the limitations that the “contact is related to the risk by a “matching group” code and that the “risk is related to the answer by the matching group code.” Claim 32 now also requires that the database manipulation program generates a numerical tally of the completed risks and displays it. The prior art does not disclose or suggest these limitations.

Support for the amendment with regard to set of building projects can be found at paragraphs 0123-0127. Support for the amendment with regard to databases can be found at paragraphs 0056-0059. A database manipulation program is supported at paragraphs 0084 and 0129. Display of the numerical tally is disclosed at paragraphs 0118-0120.

Furthermore, the Office Action correctly admits that *Phelps* fails to disclose “a question database having a question relating to the project.” However, the Office Action incorrectly assumes that it would be obvious for one of ordinary skill in the art to modify *Phelps* to include a questions database containing different questions which are associated with the risk data.

The questions of the Applicant’s invention are not only associated with the risk data. The Applicant’s questions also include codes that associate them with a specific discipline. *See*, paragraph 0056. It would not be obvious to one having ordinary skill in the art to modify the questions of *Phelps* to include such codes because there is no motivation to do so. The questions of *Phelps* are not categorized as those of Applicant and so would not need the codes as disclosed and claimed by Applicant.

With respect to the Office Actions’ assertion that *Bowman-Amuah* discloses a “contact” and “contact database” as the terms are used by Applicant. The “contacts” of *Bowman-Amuah* are merely external vendors and their contact information. “Contact” as the term is used by Applicant includes an association with a specific discipline and specific risk, so that an appropriate person may be contacted with regard to a specific risk. *See*, paragraph 0115. Thus, the references alone or in combination do not disclose or suggest the claimed invention of Applicant, not do they make the claimed invention obvious.

**Claims 33-35 and 39 were rejected under § 103(a) over *Phelps* in view of *Bowman-Amuah* in view of *Leblanc* and further in view of *Tschiegg '03*.**

Applicant reasserts its arguments as to the combination of *Phelps* and *Bowman-Amuah*.

Claim 33 has been cancelled.

Claim 34 has been amended. Claim 34 now requires the database manipulation program to display a set of completed risks with a first icon and a set of uncompleted risks with a second

icon. Both are graphical. The specification supports this amendment at paragraphs 0011, 0118-119. *Teschiegg '03* contains *only text* to indicate “active” or “complete”. *See*, paragraph 0087. *Teschiegg '03* does not disclose or suggest a non-textual graphical presentation that indicates a risk’s current state. Thus, the combination of *Phelps*, *Leblanc* and the “graphical display of a segment of risk management information” of *Teschiegg '03* do not disclose or suggest the invention of claim 34 of Applicant.

Claim 35 has been cancelled.

Claim 39 has been cancelled.

**Claims 36-38 were rejected under § 103(a) as being unpatentable over *Phelps* in view of *Bowman-Amuah* in view of *Leblanc* and further in view of *Teschiegg '05*.**

Applicant restates its arguments as to the combination of *Phelps* and *Bowman-Amuah*.

Claim 36 has been amended to include that the risk database, the contacts database and the question database be organized according to a set of “discipline group codes”. The prior art does not disclose or suggest such a database organization nor does it make such an organization obvious. Therefore, claim 36 has independently patentable.

Support for the discipline group codes can be found at paragraph 0115.

Claim 37 has been cancelled.

Claim 38 has been cancelled.

**Claims 40-42 were rejected under § 103(a) as being unpatentable over *Phelps* in view of *Bowman-Amuah* in view of *Leblanc* and further in view of *Teschiegg '05*.**

Applicant reasserts its arguments as to the combination of *Phelps* and *Bowman-Amuah*.

With respect to claim 40, *Phelps* fails to disclose a “question” as that term is used by Applicant. The question of Applicant includes a field that holds a URL link to provide the user

information that further defines the question. *See*, paragraph 0056. Such a URL link is not present in *Phelps*. Thus, *Phelps* does not disclose a question as that term is used by Applicant.

Further, *Phelps* does not disclose a “risk” as that term is used by Applicant. “Risk” as the term is used by Applicant, includes a field that holds a URL to provide the user additional information specific to that risk. *See*, paragraph 0057. No such URL is present in *Phelps*.

The Office Action correctly admits that *Phelps* fails to disclose “a contact database having a plurality of contacts.” However, the Office Action incorrectly argues that *Bowman-Amuah* discloses contacts as the term is used by Applicant. The “contacts” of the *Bowman-Amuah* reference are merely external vendors and their contact information. “Contact”, as the term is used by Applicant includes an association with a specific discipline and specific risk so that an appropriate person may be contacted with regard to a specific risk. *See*, paragraphs 0115 and 0177. Thus, the references do not disclose or suggest the invention as disclosed and claimed by Applicant.

Claim 41 has been cancelled.

Claim 42 has been cancelled.

**Claims 43-45, 46, and 47 were rejected under § 103(a) as being unpatentable over *Phelps* in view of *Bowman-Amuah* in view of *Leblanc* in view of *Tschiegg '05* and further in view of *Tschiegg '03*.**

Applicant reasserts its arguments as to the combination of *Phelps* and *Bowman-Amuah*.

Claims 43-45 have been cancelled.

Claim 46 has been amended to include the requirement of a set of information sources related to the plurality of discipline codes and where in the database organization program associates the set of information sources to the plurality of questions and the plurality of risks by

using the discipline codes. Support for the amendment to claim 46 can be found at paragraphs 0056-0057. The prior art does not disclose or suggest such a limitation. Applicant submits that Claim 46 is patentable over the prior art.

Claim 47 has been cancelled.

**Claims 49-51 rejected under § 103(a) as being unpatentable over *Phelps et. al* in view of *Tschiegg '05*.**

Independent Claim 48 has been amended to require the steps of creating a question database where the question includes a question ID and is associated with a set of discipline codes with the software program and the step of creating a risk database having at least one risk with a risk ID where the risk ID is also associated with the set of discipline codes with the software program. Furthermore, claim 49 has been amended to require further steps of providing a first set of information blocks related to the question and having a first set of network addresses and also the step of providing a second set of information blocks related to the risk and having a second set of network addresses and further associating the first set of information IDs with the question and display the first set of network addresses and to associating the second set of information IDs with the risk and display the second set of network addresses.

The prior art of record does not disclose or suggest the steps of claim 49 or those of Claim 48 from which claim 49 depends. Therefore, claim 49 is patentable over the art of record. Support for the correlation information IDs may be found at paragraphs 0056-0057, 0084-0085, 0164 and 0172.

Claim 50 has been amended to further define the invention by requiring the further step of creating a risk database where the risks have a completion status state identifier with the software program and displaying the plurality of risks according to completion status state

identifier and further creating a set of totals for the completion status state identifier and display the totals with the software program. Support for the completion status identifiers may be found at paragraphs 0118-0120.

The Office Action correctly admits that *Phelps* fails to disclose statistical mapping of a completed risk and an uncompleted risk. The Office Action relies on *Tschiegg '05* and its disclosure of a risk management information interface system having statistical mapping to disclose comparative statistical calculation results. However, comparative statistical calculation is not the same thing as the method disclosed by Applicant where each of the risks has the status state identifier associated with a graphical icon and where those icons are totaled to produce a display of the set of totals. Furthermore, it would not be common sense for one of reasonable skill in the art to arrive at the method disclosed and claimed by Applicant from the comparative statistical calculation of *Tschiegg '05*. Therefore, claim 50 has independent patent significance over the art of record and should be patentable.

Claim 51 has been cancelled.

### **Conclusion**

Claims 1-51 are pending in the application. Claims 1, 2, 8-10, 12, 15, 17-18, 20-23, 28, 29, 32, 34, 36, 40, 46, 48-50 have been amended. Claims 3, 5-7, 11, 13, 14, 16, 19, 24-27, 30-31, 33, 35, 37-39, 41-45, 47 and 51 have been cancelled.

Applicant has diligently read and studied the Office Action and the reference cited thereby and has undertaken to amend its claims and to more distinctly point out and claim the invention.

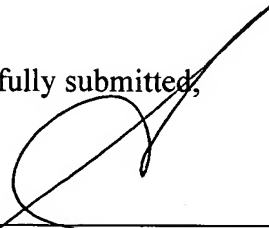
It is believed that no additional search is required since the amendments made were well within the specification and the bounds of the art of record as discovered in the first search by the

Office. For the reasons set forth above, it is believed that all the claims are now in condition for allowance.

Should it facilitate allowance of the Application, the Office is invited to telephone the undersigned agent of record.

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Respectfully submitted,



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George R. Schultz  
Reg. No. 35,674  
SCHULTZ & ASSOCIATES, P.C.  
One Lincoln Centre  
5400 LBJ Freeway, Suite 1200  
Dallas, Texas 75240  
(214) 210-5940 telephone  
(214) 210-5941 facsimile